

REMARKS

I. Status of the Claims

In the Final Office Action mailed May 28, 2008, the Examiner rejected claims 1, 11, 14, 17, 24, and 37¹ under 35 U.S.C. § 102(b) as being anticipated by *Transfer Fees are Not Fair, Small brokers Say: Boost Cost of Hiring: Head of Brokerage Committee Plans to Launch Complaint*, by DeCloet (Hereinafter “the DeCloet Article”); rejected claims 2-10, 15-23, and 28-36 under 35 U.S.C. § 103(a) as being unpatentable over the *DeCloet Article* in view of *Harycki et al.* (U.S. Patent Publication No. 2002/0077966); and rejected claims 12, 25, and 38 under 35 U.S.C. § 103(a) as being unpatentable over the *DeCloet Article* in view of *Harycki et al.* and *CD's are Not Risk-Free, So Shop Around*, by the Pittsburgh Post - Gazette (Hereinafter “the Post Article”).

By this amendment, Applicants propose to amend claims 1, 14, 27, 28, and 30 and cancel claims 8, 21, and 34 without prejudice or disclaimer. However, by amending these claims, Applicants do not accede to any of the outstanding rejections. To the contrary, Applicants respectfully traverse the rejections contained in the Final Office Action. Upon entry of this amendment, claims 1-7, 9-12, 14-20, 22-25, 27-33, and 35-38 will remain pending in this application.

II. Rejection of claims 1, 11, 14, 24, 27, and 37 under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejections of claims 1, 11, 14, 24, 27, and 37 under 35 U.S.C. § 102(b) because the *DeCloet Article* fails to disclose each and every element of Applicants’ claims.

¹ The heading of the rejection indicates that claims 1, 11, 14, 17, 24, and 37 are rejected under 35 U.S.C. § 102(b). However, the body of the rejection indicates that claims 1, 11, 14, 24, 27, and 37 are rejected under 35 U.S.C. § 102(b). The arguments presented herein are based on a rejection of claims 1, 11, 14, 24, 27, and 37 under 35 U.S.C. § 102(b).

Amended independent claim 1 recites a computer-implemented method, for providing to an investor having a first certificate of deposit, a second certificate of deposit, the method comprising:

receiving, at a server of a second financial institution, funds associated with the first certificate of deposit held with a first financial institution, the funds having been reduced by a penalty for closing the first certificate of deposit;

increasing, by the second financial institution, the funds by a first amount based on the reduced funds due to the penalty; and

transferring the increased funds to a second certificate of deposit having a rate of return greater than the first certificate of deposit.

The *DeCloet Article* fails to teach or suggest the steps of receiving, increasing, and transferring, as recited in amended claim 1.

The *DeCloet Article* relates to fees charged to clients to “transfer their assets from one brokerage firm to another.” (The *DeCloet Article*, p. 1.) In rejecting claim 1, the Examiner alleges that “[t]his fee is taken from the account during the transfer.” (Final Office Action, p. 4.) The Examiner is incorrect. The *DeCloet Article* merely discloses that the “firm getting the new customer” often pays this fee for the customer. (The *DeCloet Article*, p. 1.) Nowhere does the *DeCloet Article* disclose that the brokerage account of the customer or the assets of the brokerage account are reduced by the fee amount. Accordingly, the *DeCloet Article* fails to teach or suggest “receiving, at a server of a second financial institution, funds associated with the first certificate of deposit held with a first financial institution, the funds **having been reduced by a penalty** for closing the first certificate of deposit,” as recited in claim 1. (Emphasis added.) Moreover, because the *DeCloet Article* fails to disclose reducing the brokerage

account or the assets by the fee amount, it also fails to teach or suggest "increasing, by the second financial institution, the funds by a first amount based on the reduced funds due to the penalty," as recited in claim 1.

The *DeCloet Article* also makes no disclosure of what happens to the customer assets once they are transferred from one brokerage firm to another. Accordingly, the *DeCloet Article* fails to teach or suggest "transferring the increased funds to a second certificate of deposit having a rate of return greater than the first certificate of deposit," as recited in claim 1.

For at least the above reasons, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn and the claim allowed.

Independent claims 14 and 27, although of different scope than claim 1, distinguish over the *DeCloet Article* for at least the same reasons as claim 1. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 14 and 27 under 35 U.S.C. § 102(b) and the timely allowance of these claims.

Dependent claims 11, 24, and 37 are allowable at least for the reasons set forth above in connection with independent claims 1, 14, and 27, and because they recite features not taught or suggested by the cited references. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 11, 24, and 37 under 35 U.S.C. § 102(b) and the timely allowance of the claims.

II. Rejections under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 2-7, 9-12, 15-20, 22-25, 28-33, and 35-38 under 35 U.S.C. § 103(a) because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *Id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Dependent claims 2-7, 9-12, 15-20, 22-25, 28-33, and 35-38 include all the elements recited in respective independent claims 1, 14, and 27. As discussed above,

the *DeCloet Article* fails to teach or suggest the steps of receiving, increasing, and transferring, as recited in independent claims 1, 14, and 27. *Harycki et al.* and the *Post Article*, do not cure the above noted deficiencies of *DeCloet Article*, nor does the Examiner rely on *Harycki et al.* and the *Post Article* for such teachings. Accordingly, dependent claims 2-7, 9-12, 15-20, 22-25, 28-33, and 35-38 are allowable for at least the same reasons set forth above in connection with claims 1, 14, and 27.

CONCLUSION

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 1-7, 9-12, 14-20, 22-25, 27-33, and 35-38 in condition for allowance. Furthermore, Applicants respectfully point out that the Final Office Action presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that the amended claims are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration of the application, and the timely allowance of the pending claims.

The preceding remarks are based on the arguments presented in the Final Office Action and, therefore, do not address patentable aspects of the claims that were not addressed by the Examiner in the Final Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

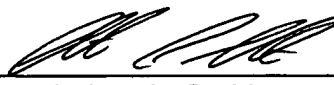
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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